

REMARKS

Claim 1 has been amended to include the limitation of claim 2. Claims 2, 4, 6, 12, 14, 16, 18 and 20 have been canceled. After the present amendments, claims 1, 3, 5, 11, 13, 15, 17, and 19 correspond to claims 2, 4, 6, 12, 14, 16, 18 and 20, respectively, prior to the present amendment.

Claim 3 has been amended to correct a typographical error.

Claims 1, 3, 5, 11, 13, 15, 17, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bagaoisan et al. (U.S. Patent No. 6,152,909) (hereinafter: "Bagaoisan") in view of Grasso, III et al. (U.S. Patent No. 6,375,651) (hereinafter: "Grasso"). Claims 2, 4, 6, 12, 14, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bagaoisan in view of Grasso and further in view of Windischman et al. (U.S. Patent No. 2,716,983) (hereinafter: "Windischman").

The 35 U.S.C. 103(a) rejection of claims 1, 3, 5, 11, 13, 15, 17, 19 is moot in view of the present amendments to the claims.

Removal of the 35 U.S.C. 103(a) rejection applied to claims 2, 4, 6, 12, 14, 16, 18 and 20 is believed to be in order based on the following remarks.

The position of the Office in the rejection of claim 2 (amended claim 1) is that Bagaoisan and Grasso disclose the catheter substantially as claimed in claim 2 except that these references do not disclose or suggest a first cut surface angled in the proximal direction of the catheter, a ledge surface which is substantially parallel to the longitudinal axis of the catheter and extends from the first cut surface in the proximal direction and a second concave cut surface extending from the ledge surface and angled in the proximal direction of the catheter (as recited in claim 2). Windischman is alleged by the Office to teach providing a cut surface of "the catheter" (Action, page 5, line 12) as recited in claim 2 "for the purpose of providing a distal end opening structure to the lumen that helps prevent the lumen from becoming clogged." (Action, page 5, last three lines).

The Office concludes that it would have been obvious for a person of ordinary skill in the art to modify the cut surface of Bagaoisan as modified by Grasso with the cut surfaces as taught by Windischman to provide a distal end opening structure that helps prevent the suction lumen from being clogged.

Obviousness under 35 U.S.C. § 103(a) requires a suggestion, teaching, or motivation to combine the prior art references as

proposed by the Office. A reason must be provided as to why the skilled artisan, with no knowledge of the claimed invention, would have selected the components for combination in the manner claimed.

In the present case the Office has identified the providing of a distal end opening structure that helps prevent the suction lumen from being clogged as the motive for combining Bagaosian, as modified by Grasso, with Windischmann. However, applicants respectfully submit that the prior art does not support the motive identified by the Office for combining the references.

The invention of Windischman is a piercing needle - not a catheter as suggested in the Action - and the reason for the design of the needle is to prevent coring or clogging of the needle by a small piece of a diaphragm or skin during piercing. The Office has not shown that a design of a piercing needle to prevent clogging of the needle with a piece of a rubber diaphragm or skin would be reasonably expected by a person of ordinary skill in the art to prevent clogging of a suction catheter as disclosed in Bagaoisan. Without such expectation, the art cannot provide a proper motive to modify the catheter of Bagaoisan (and Grasso) using the teachings of Windischman. As noted by the United States Court of Appeals for

the Federal Circuit in the case of *Velander v. Garner*, 68 USPQ2d 1769, at 1772 (2003):

If all the elements of an invention are found in a combination of prior art references, a proper analysis under §103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. *In re Vaack*, 947 F.2d 488, 493 [20 USPQ2d 1438] (Fed. Cir. 1991) (citing *In re Dow Chem. Co.*, 837 F.2d 469, 473 [5 USPQ2d 1529] (Fed. Cir. 1988)). Both the suggestion and the reasonable expectation of success "must be founded in the prior art, not in the applicant's disclosure." *Id* (Emphasis added).

Removal of the 35 U.S.C. 103(a) rejections of the claims is in order and is respectfully requested.

The foregoing is believed to be a complete and proper response to the Office Action dated January 10, 2006, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of

PATENT APPLN. NO. 10/761,806  
RESPONSE UNDER 37 C.F.R. §1.111

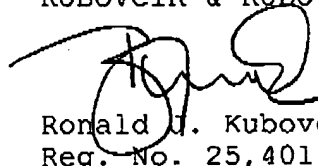
**PATENT  
NON-FINAL**

time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

KUBOVCIK & KUBOVCIK



Ronald J. Kubovcik  
Reg. No. 25,401

Atty. Case No. NPR-132  
The Farragut Building  
Suite 710  
900 17th Street, N.W.  
Washington, D.C. 20006  
Tel: (202) 887-9023  
Fax: (202) 887-9093  
RJK/jbf